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IN THE

Supreme Court of the United States

No. 608 October Term, 1937.

LINCOLN ENGINEERING CO. OF ILLINOIS,
Defendant-Petitioner,

v.

STEWART-WARNER CORPORATION,
Plaintiff-Respondent.

Brief for Petitioner in Support of Petition for Writ of Certiorari.

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No. . October Term, 1937.

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Defendant-**Petitioner,**

vs.

STEWART-WARNER CORPORATION,
Plaintiff-**Respondent.**

BRIEF FOR PETITIONER IN SUPPORT OF PETITION FOR WRIT OF CERTIORARI.

To the Honorable, the Chief Justice and Associate Justices of the Supreme Court of the United States:

Opinions of the Courts Below.

The opinion of the Circuit Court of Appeals for the Seventh Circuit on the appeal in the case at bar, is reported at 91 Fed 2d 757 (and is also in the Transcript of Record herein on pages 638 to 644). The Order of said Court on the Petition for Rehearing is unreported but is reproduced in the Transcript of Record filed herewith (R p 719).

The Opinion* of the District Court is reported at 15 F. Supp. 571, and is also reproduced in the Transcript of the Record filed herewith on pages 603 to 620, inclusive.

*Subsequently, the District Court also filed a second opinion on the denial of defendant's Petition for Rehearing in the trial court. This second opinion is reported at 16 F. Supp. 778. As defendant took no appeal, and as indeed no appeal lies from such denial of the petition for rehearing,

JURISDICTION.

The grounds on which the jurisdiction of this Court is invoked, are:

1. The date of the judgment to be reviewed was June 29, 1937 (R p 645 for the Judgment and R p 628-644 for the Opinion). Petitioner duly filed a timely Petition for Rehearing in the Circuit Court of Appeals (R. pp. 647-718), but the same was denied. The date of the Order Denying the Petition for Rehearing is September 15th, 1937.

2. The judgment was rendered in a suit in equity brought under the Patent Statutes to determine the issues of validity and infringement of letters patent for invention issued by virtue of Sec. 4886 of the Revised Statutes of the United States (U. S. C. Title 35, Sec. 31).

3. The statute under which jurisdiction is invoked is Sec. 240 (a) of the Judicial Code (U. S. C. Title 28, Sec. 347).

4. Cases sustaining jurisdiction are:—

Gypsy Oil Co. v. Escoe, 275 U. S. 498
(on timeliness of Petition for Writ of Certiorari);

---

the Transcript of Record before the Court of Appeals for the Seventh Circuit and likewise the Transcript of Record filed herewith, contain

neither the additional and newly discovered evidence which formed the basis, inter alia, of defendant's Petition for Rehearing in the trial Court,

nor the opinion of the trial Court denying such Petition for Rehearing.

Likewise, the Transcript of Record does not include the further oral statements of the trial Court on the denial of defendant's Motion for Supersedeas, as defendant took no appeal from such denial of supersedeas. These latter oral remarks of the trial Court are not reported in the Federal Reporter system, although they are reported at 31 U. S. P. Q. 195.

I. T. S. Rubber Co. v. Essex Rubber Co., 272 U. S. 429;
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(conflict as to scope or infringement of same patent);
Concrete Appliances Co. v. Gomery, 269 U. S. 177
(conflict as to validity of same patent);
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Adams Grease Gun Corp. v. Bassick Mfg. Co., 285 U. S. 531;
Smith v. Hall, 298 U. S. 652;
(conflict with applicable decisions of this Court).

STATEMENT.

The facts are sufficiently stated in the petition.

STATUTES.

The statute under which this case arises and which is necessary to be considered, is section 4886 of the Revised Statutes (U. S. C. Title 35, Sec. 31). That statute reads as follows:—

> "Any person who has invented or discovered any new and useful art, machine, manufacture, or composition of matter, or any new and useful improvements thereof, or who has invented or discovered and asexually reproduced any distinct and new variety of plant, other than a tuber-propagated plant, not known or used by others in this country, before his invention or discovery thereof, and not patented or described in any printed publication in this or any foreign country, before his invention or discovery thereof or more than two years prior to his application, and not in public use or on sale in this country for more than two years prior to his application, unless the same is proved to have been

abandoned, may, upon payment of the fees required by law, and other due proceeding had, obtain a patent therefor."

Section 4888 of the Revised Statute (U. S. C. Title 35, Sec. 33) is also involved in the case, and is as follows:—

"Before any inventor or discoverer shall receive a patent for his invention or discovery, he shall make application therefor, in writing, to the Commissioner of Patents, and shall file in the Patent Office a written description of the same, and of the manner and process of making, constructing, compounding, and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art or science to which it appertains, or with which it is most nearly connected, to make, construct, compound, and use the same; and in case of a machine, he shall explain the principle thereof, and the best mode in which he has contemplated applying that principle, so as to distinguish it from other inventions; and **he shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery.** The specification and claim shall be signed by the inventor. No plant patent shall be declared invalid on the ground of noncompliance with this section if the description is made as complete as is reasonably possible."

Section 3 of the Act of October 15, 1914, 38 Stat. L. 731, known as the Clayton Act, and also involved in the cause, is as follows:

"That it shall be unlawful for any person engaged in commerce, in the course of such commerce, to lease or make a sale or contract for sale of goods, wares, merchandise, machinery, supplies, or other commodities, whether patented or unpatented, for use, consumption, or resale within the United States or any Territory

thereof or the District of Columbia or any insular possession or other place under the jurisdiction of the United States, or fix a price charged therefor, or discount from, or rebate upon, such price, on the condition, agreement, or understanding that the lessee or purchaser thereof shall not use or deal in the goods, wares, merchandise, machinery, supplies, or other commodities of a competitor or competitors of the lessor or seller, where the effect of such lease, sale, or contract for sale or such condition, agreement, or understanding may be to substantially lessen competition or tend to create a monopoly in any line of commerce."

SPECIFICATION OF ERRORS.

The errors which petitioner will urge if the writ of certiorari is allowed, are the following:

1) The Court of Appeals for the Seventh Circuit erred in holding (in conflict with 81 Fed 2d 786)

that the hose coupler purported to be defined in the coupler part of the Butler claim-language * is both patentably different from the prior-art hose couplers,

and at the same time holding

that such coupler part of the claim-language is broad enough to include plaintiff-respondent's commercial form of hose coupler (specifically different from that shown in Butler Figure 2) in conjoint use with which petitioner's grease-cup is charged contributorily to infringe.

2) The Court of Appeals for the Seventh Circuit erred in holding Butler claim 2 both valid and at the same time

* Different claims of the Butler patent were involved, but the coupler parts of the claim-language are substantially the same in both instances.

infringed by the conjoint use of an old pump and so-called "Alemite-hydraulic" coupler sold by respondent, with a grease-cup sold by petitioner.

3) The Court of Appeals for the Seventh Circuit erred in holding, in effect, that the inventor of a presumably improved and patentable hose coupler can validly claim his specific hose coupler in combination with an old grease-cup or so-called lubricant-receiving "nipple" and an old pump or compressor; with which old devices hose couplers of the prior art had theretofore been used, and without which old devices the inventor's improved hose coupler has no utility.

4) The Court of Appeals for the Seventh Circuit erred in holding, in effect, that one who has presumably invented a better hose coupler can claim (as an allegedly new "combination") the use of old grease-cups and old pumps with his presumably improved hose coupler.

5) The Court of Appeals for the Seventh Circuit erred in holding, in effect, that a patentee may use the patent laws to prevent the competitive sale of old and unpatentable grease-cups or so-called "nipples" which may be usable, or indeed intended to be used with the patentee's allegedly improved and patentable hose coupler, as assertedly manufactured by plaintiff.

6) The Court of Appeals for the Seventh Circuit erred in holding, in effect, that the owner of the patent* can extend the monopoly of a so-called "combination" claim (drawn to an improved device plus two old devices), to pre-

*Assuming (without conceding) for the purposes of this issue, that the patent owner (plaintiff-respondent here) manufactures and sells, and gives wide distribution to a coupler in fact responding to the coupler-defining portion of the claim language.

vent the use of an old-style grease-cup or so-called "nipple" of competitive manufacture, with a hose coupler assertedly in accordance with the patent and manufactured and sold by the patent owner and with an old-style pump, also supplied by the patent owner.

7) The Court of Appeals for the Seventh Circuit erred in holding, in effect, that a patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, can re-patent the old combination by re-claiming the combination with the improved element substituted for the old element.

8) The Court of Appeals for the Seventh Circuit erred in holding, that the multi-jawed chuck-type coupler purported to be defined in the coupler-defining portion of the Butler claim-language is patentably distinct from, or represents a patentable improvement or invention over the multi-jawed chuck-type hose couplers of the prior art.

9) The Court of Appeals for the Seventh Circuit erred in failing to reverse the decree of the District Court.

10) The Court of Appeals for the Seventh Circuit erred in not dismissing the bill of complaint for want of equity.

11) The Court of Appeals for the Seventh Circuit erred in denying defendant-petitioner's petition for re-hearing.

SUMMARY OF ARGUMENT.

The points of the argument hereinbelow follow the reasons relied upon for the allowance of the writ, as outlined in pages 19 to 24 of the Petition for Writ of Certiorari, and are briefly:

Argument Point 1:

The coupler part of the Butler claim-language,

construed in the light of the applicable portions of the specification and drawings of the Butler patent [1]

and/or

construed in the light of the prior art so as in some way to be distinguishable over the prior art hose couplers

is **not** readable on and does **not** cover the respondent's commercial form of coupler, sometimes referred to as the "Alemite Hydraulic" coupler, **in conjoint use with which petitioner's grease-cup is charged contributorily to infringe**, and (as held by the United States Circuit Court of Appeals for the Eighth Circuit, in respondent's suit against Jiffy Lubricator Co., 81 Fed 2d 786) respondent's said commercial form of hose coupler here involved is **not** in fact the coupler of the Butler patent.

Argument Point 2:

A patentee may not re-monopolize old-style grease-cups on the basis of an asserted improvement in a hose coupler [2] usable therewith.

Argument Point 3:

The Butler claim in suit is invalid or unpatentable because drawn to an old and exhausted combination of pump,

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[1] Figure 2 of the Butler drawings, and the corresponding parts of the specification beginning in line 87, of page 2 of the Butler specification (R. p. ~~426~~ 468), down to line 5 of page 3 of the Butler specification (R. p. 469) and lines 14 to 36 inclusive of page 3 of the Butler specification (R. p. 469).

[2] The hose coupler improvement may, for the purposes of this point of the argument, be assumed to be a patentable hose coupler.

grease-cup and hose coupler, whereas the patentee's improvement (if any), is at best merely in the internal construction or mechanism of the hose coupler. The construction and mode of operation of the old "combination" of pump, grease-cup and coupler, is otherwise unchanged.

The Butler claim in suit violates Section 4888 of the Revised Statutes in that the patentee has commingled in the patent claim

(a) that which is his (the improved hose coupler) with

(b) that which is in the public domain (old-style grease-cup and old-style pump);—

the Statute requiring, inter alia, that the patentee "shall particularly point out and distinctly claim the part, improvement, or combination which he claims as his invention or discovery".

Argument Point 4-a:

Section 3 of the Clayton Act prohibits the monopoly such as herein asserted by respondent, and respondent may not restrict the use of the assertedly Butler-invented hose-coupler of its own manufacture, to its periodic attachment solely to grease-cups of its own manufacture (to the exclusion of grease-cups manufactured and sold by petitioner);—notwithstanding respondent's ownership of a patent assertedly covering its hose-coupler in so-called "combination", broadly, with any old grease-cup;

or otherwise stated:

Respondent may not impose as a condition of sale of its assertedly Butler-invented hose couplers, that the purchasers shall not use the same in conjunction with old-style

grease-cups manufactured and sold by petitioner;—notwithstanding respondent's ownership of the patent in suit which claims an improved hose coupler in so-called combination with an old-style grease-cup. Such condition of sale violates Section 3 of the Clayton Act.

Argument Point 4-b:

Under the principle of estoppel, purchasers of respondent's assertedly Butler-invented "Alemite Hydraulic" couplers are impliedly licensed to use the same with any old-style and unpatentable grease-cups including those of petitioner.

ARGUMENT OF POINT I.

Petitioner's old-style (and unpatented) grease-cup or so-called "nipple" or "fitting"

cannot possibly constitute *contributory* infringement as charged, because

respondent's own commercial "Alemite Hydraulic" coupler (in conjoint use with which petitioner's unpatentable grease-cup or "nipple" is charged *contributorily* to infringe) is not in fact the Butler coupler because not "according to the drawing or specifications on which the claim in suit read", as expressly held by Circuit Court of Appeals for Eighth Circuit in respondent's earlier suit against Jiffy Lubricator Co. (81 Fed 2d 786, 788).

While the Butler patent in suit discloses four specifically different multi-jawed "chuck" type hose-couplers*, the coupler part of the Butler claim-language is readable only upon one of the four Butler couplers disclosed, to wit, that shown in Butler Figure 2. The other three Butler couplers (while shown and described in the patent) are not covered in any claim (presumably because they were old and unpatentable multi-jawed "chuck" type hose couplers).

One of the separate and distinct defenses of non-infringement in the case at bar is that plaintiff-respondent's commercial "Alemite Hydraulic" coupler is not, in fact, the Butler coupler. If that is true then non-infringement is conclusively established in the case at bar on that one ground alone, irrespective of the other defenses of non-infringement and invalidity covered by the other Argument of Points in this brief.

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*shown respectively in Figures 2, 3, 4 and 9 of the Butler drawings.

Then, if plaintiff-respondent's own commercial "Alemite Hydraulic" coupler is **not** the coupler of the Butler claim, then the conjoint use therewith of defendant-petitioner's grease-cup or "nipple" can **not** constitute direct infringement. In the absence of such direct infringement, there can be no contributory infringement (Popular Mechanics v. Brown, 245 Fed 859, 860, CCA 7).

In the Jiffy case, the Circuit Court of Appeals for the Eighth Circuit held that plaintiff-respondent's "Alemite Hydraulic" coupler is **not** the coupler defined by the coupler part of the Butler claim-language for the reason that:

> the coupler part of the claim-language requires that the nipple-engaging means (the three radially-movable locking jaws 40) be **compressively** actuated. The only means of "compression" disclosed, are Butler's **resilient spring fingers** 42, which do subject the radially-movable locking jaws 40 to **spring-compression.** Plaintiff-respondent's commercial "Alemite Hydraulic" couplers do **not** have **any** such spring fingers nor any other resilient or spring-like or "**compressive**" jaw-actuating means. Instead, the jaws of the "Alemite Hydraulic" coupler are actuated by an unyielding cam or wedge surface. . . . .

The Court of Appeals for the Eighth Circuit in plaintiff-respondent's suit against Jiffy Lubricator Co. (81 Fed 2d 786), affirming the trial court, held that **neither** the accused Jiffy coupler nor indeed plaintiff's own commercial "Alemite Hydraulic" coupler responded to the coupler part of the Butler claim-language for the above-outlined reason.

The coupler parts of Butler claims 1 and 2 are indistinguishable in substance as the following parallel columns of the coupler parts of Butler claims 1 and 2 will show:

THE COUPLER PARTS OF THE BUTLER CLAIMS.

Of Butler Claim 1. Scope adjudicated by C C A 8 (81 Fed 2d 786). (Certiorari denied 299 U. S. 554.)	Of Butler Claim 2 in Suit. Claim held invalid at 15 F. Supp. 410, on authority of 298 U. S. 415.
"a coupling for connecting said compressor and nipple,"	"a coupling member for connecting said compressor and nipple"
"the coupling comprising (*coupler elements 1 to 5 below*)	"comprising" (*coupler elements 1 to 5 below*)
1) "a cylinder" (*parts 31 & 32 in Figure 2 constituting the body or housing of the coupler*).	1) "a cylinder (*parts 31 & 32 in Figure 2 constituting the body or housing of the coupler*),
2) "a piston (*43 & 45*) movable within the cylinder, and having"	2) "a piston (*43 and 45*) movable within the cylinder, and having
3) "an aperture (*48*) for the discharge of lubricant therethrough," "and"	3) "an aperture (*48*) for the discharge of lubricant thereof"
4) "an apertured seat" (*washer 51*)	4) "an apertured sealing seat (*washer 51*) carried by said piston"
"for engagement with the end of the nipple,"	"for engagement with the end of the nipple, connecting the piston aperture with a passage through the nipple,"

Coupler parts of Butler claims (continued).

Claim 1	Claim 2
5) "means (*jaws 40*) carried by the cylinder"	5) "radially movable locking elements (*jaws 40*) carried by the cylinder coacting with the nipple and
"for compressively engaging [2] about the nipple"	
"for locking said parts together against longitudinal displacement and"	"actuated by said piston" (*given its radial nipple-gripping motion by the radially* compressive *action of the radially resilient spring-fingers 42 carried by the piston 43 & 45*).
"actuated by said piston". (*43 & 45 + 24*) (*given its radial nipple-gripping motion by the radially* compressive *action of the radially resilient spring-fingers 42 carried by the piston 43 & 45*).	"for compressively clutching [2] the elements upon the nipple"
"whereby the pressure of the lubricant on said piston [1] will move the piston [1] to forcibly compress [2] said means (*jaws 40*) while the lubricant is passing through said connecting parts."	"whereby the pressure of the lubricant on said piston [1] will move the piston [1] to forcibly compress [2] said means (*jaws 40*) while the lubricant is passing through said connecting parts."

1) *The piston (43 & 45 + 42) within the coupler.*
2) *By the radially* compressive *action of the radially resilient spring-fingers 42 carried by the piston 43 & 45).*

(Parenthetical statements ours. The numerals in parentheses identify the parts or elements similarly numbered in Figure 2 of Butler drawing.)

The Court of Appeals for the Eighth Circuit held that respondent's own "Alemite Hydraulic" coupler (in conjoint use with which petitioner's grease-cup or so-called "nipple" is charged *contributorily* to infringe) is **not** "according to the drawing or specifications on which the claim in suit reads" (81 Fed 2d 789). The coupler-language of both Butler claims is substantially the same.

Petitioner believes that for the purposes of this Petition for Writ of Certiorari, it is sufficient for it to show to this Court that in the case at bar the Court of Appeals for the Seventh Circuit **did** definitely adjudicate the scope of the Butler patent in conflict with the adjudication of the scope of the same patent by the Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786).

To show what was before the Court of Appeals for the Eighth Circuit in the Jiffy case and what that Court decided, defendant-petitioner in the case at bar introduced in evidence (R. pp. 98, 99, 403) a drawing of plaintiff-respondent's own commercial coupler (or so-called "Alemite Hydraulic" coupler) referred to in the Opinion of the Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786). This Court also has available the entire record in the Jiffy case, as that record was filed in this Court by plaintiff-respondent with its own petition to this Court in the Jiffy case (No. 114, Oct. Term, 1935; certiorari denied 299 U. S. 554).

Plaintiff-respondent's commercial form of coupler (the so-called "Alemite Hydraulic" coupler) which the Court of Appeals for the Eighth Circuit in the Jiffy case held **not** to be the coupler of the Butler patent **and to be outside the scope thereof,** is identically the same as plaintiff-respondent's commercial "Alemite Hydraulic" coupler in the case at bar (in conjoint use with which defendant-petitioner's

accused grease-cup or "nipple" is charged contributorily to infringe).

Plaintiff-respondent's own "Alemite Hydraulic" coupler is also substantially identical with the exculpated Jiffy coupler.* The Court of Appeals for the Eighth Circuit not only held the Jiffy coupler to be outside the scope of the Butler patent, but also clearly and expressly and necessarily excluded plaintiff-respondent's "Alemite Hydraulic" coupler from the scope of the Butler patent. This exclusion of plaintiff-respondent's own "Alemite Hydraulic" coupler from the scope of the Butler patent follows both from the fact that it is substantially identical with Jiffy's accused and exculpated coupler*, as well as from the Court's statements in its Opinion (81 Fed 2d 786).

The Court of Appeals for the Eighth Circuit was indeed compelled specifically to pass upon plaintiff-respondent's own so-called "Alemite Hydraulic" coupler for the reason that plaintiff represented the commercial success of its own "Alemite Hydraulic" coupler as one of the reasons why Butler Claim 1 should be given the broad interpretation necessary for plaintiff's success in that suit, and also because plaintiff-respondent urged upon the Court of Appeals for the Eighth Circuit that the coupler part of Butler Claim 1 should be given a broad enough interpretation to make the Jiffy coupler an infringement, for otherwise plaintiff-respondent's own "Alemite Hydraulic" coupler would of necessity be **outside** the scope of its own Butler patent. In **Appendix I** appended to this brief we have excerpted the pertinent portions from plaintiff-respondent's

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* the substantial identity of the Jiffy coupler and the "Alemite Hydraulic" coupler was asserted and urged in the Jiffy case by respondent.

briefs addressed to the Circuit Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786). These excerpts further show just what plaintiff-respondent did urge upon that Court as to the scope of the Butler patent.

The Circuit Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786) flatly denied plaintiff-respondent's contentions as to the scope of the Butler patent and clearly divested Butler of any vestige of inventorship with respect to plaintiff-respondent's own commercial "Alemite Hydraulic" coupler (in conjoint use with which defendant-petitioner's accused grease-cup or "nipple" is charged contributorily to infringe in the case at bar). The Court of Appeals for the Eighth Circuit said:

> "The plaintiff has **not** made or sold **any** coupler constructed according to the above drawing and specifications of its Butler patent, **nor** had it made or sold **any** couplers in which the pressure of the lubricant actuated the compression or gripping of the parts upon the bearing nipple **until long after it had received examples of the defendant's so-called Jiffy lubricator.**"
>
> (81 Fed 2d 786, 788.)

> "the plaintiff had **not** manufactured for sale **any** couplers according to the drawing or specifications on which the **claim** in suit reads"
>
> (81 Fed 2d 786, 788.)

> "The claim that Butler accomplished a new and useful result in the industry and therefore is entitled to broad protection (Smith v. Snow, 294 U. S. 1, 14, and cases there cited) is **without** merit. As was said in Dernell Potato Products Co. v. Snelling, (CCA 2) 38 Fed 2d 788, 789:
>
> 'The **appellant's patent has not been put to commercial use**, and, therefore, it is not entitled to

> a construction of any broader scope than it is clearly required to be given."
>
> (81 Fed 2d 786, 793.)

The Court of Appeals for the Seventh Circuit in the case at bar definitely rejected the conclusion reached by the Court of Appeals for the Eighth Circuit with respect to the scope of the Butler patent and held, **in conflict with the Eighth Circuit**, that plaintiff-respondent's own commercial "Alemite Hydraulic" coupler did embody Butler's coupler invention.

In **Appendix II** appended to this brief, we have reproduced pages 49 to 54 inclusive of the court reporter's transcript of respondent's oral argument before the Circuit Court of Appeals for the Seventh Circuit in the case at bar (not reproduced in the record), wherein respondent's counsel, Mr. Williams, admitted to that Court (responsive to Judge Evans' pointed question) that in order for plaintiff-respondent to prevail in the case at bar it was necessary for that Court "to reach a different conclusion" from that reached by the Circuit Court of Appeals for the Eighth Circuit in the Jiffy case with respect to the scope of the Butler patent. This further confirms the fact that the Court of Appeals for the Seventh Circuit in the case at bar did reach a conclusion as to the scope of the Butler patent, in conflict with the conclusion reached by the Court of Appeals for the Eighth Circuit as to the scope of the same patent.

Plaintiff-respondent's own commercial "Alemite Hydraulic" coupler is **not** in fact the coupler defined in the coupler part of the Butler claim-language, for the reason relied upon by the Court of Appeals for the Eighth Circuit, whose decision (81 Fed 2d 786) is in and of itself suffi-

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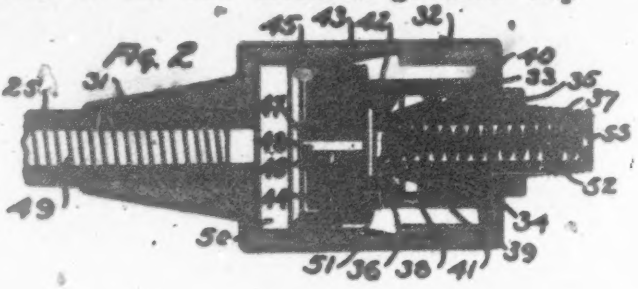
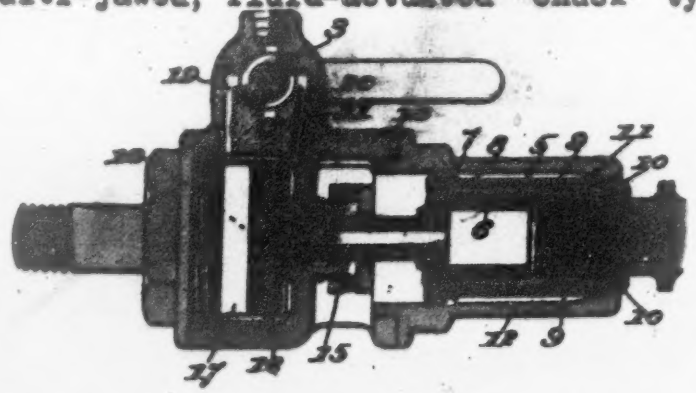
PAGE

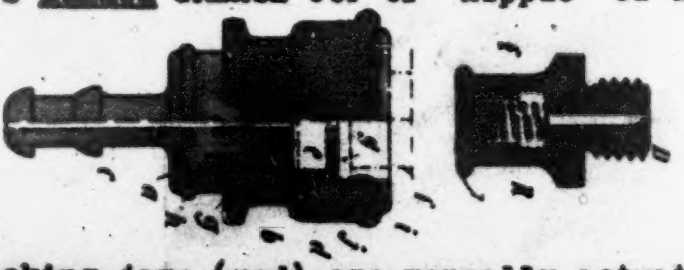
BUTLER'S assertedly improved HOSE-COUPLER of the multi-jawed, fluid-actuated "chuck" type coupled to an OLD headed grease-cup



NEWTON'S earlier HOSE-COUPLER of 1914 of the multi-jawed, fluid-actuated "chuck" type



SENG'S 1915 HOSE-COUPLER <u>for GREASE-GUNS</u> and SENG'S <u>headed</u> GREASE-CUP or "nipple" of 1915



SENG'S locking jaws (red) are manually actuated as distinguished from the "fluid-actuation" of the locking jaws in Newton and Butler although Seng's sealing member (orange) is "fluid-actuated" precisely as in Butler.

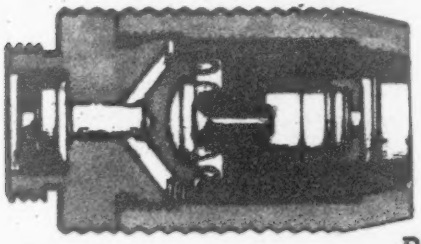
The DEVICES before the

Circuit Court of Appeals for the Eighth Circuit

in Respondent's suit against Jiffy Lubricator Co.

81 Fed 2d 786 (certiorari denied 299 U.S. 554)

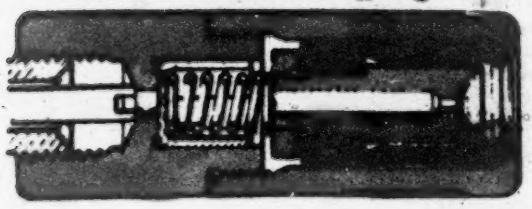
JIFFY'S Coupler held OUTSIDE the scope of Coupler Part of BUTLER claim-language



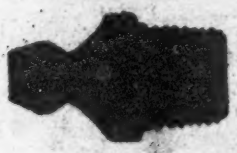
Respondent's own "pin-fitting" type grease-cup asserted (in the Jiffy suit) to be the "nipple" of BUTLER claim 1

This is grease-cup of Respondent's now-expired Gullborg pat. 1,307,734 which the Court at 298 U.S. 415 held could NOT be broadly re-monopolized under said earlier Gullborg patent

Respondent's OWN COUPLER ("Alemite Hydraulic") held OUTSIDE the scope of coupler part of BUTLER claim-language.



Respondent's OLD and unpatentable headed grease-cup

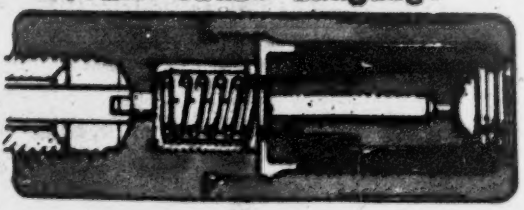


The DEVICES before the

Circuit Court of Appeals for the Seventh Circuit

IN THE CASE AT BAR: 91 Fed 2d 757

Respondent's OWN COUPLER
("Alemite Hydraulic")
held WITHIN the scope
of coupler part of
BUTLER claim-language



Petitioner's OLD
and unpatentable
headed grease-cup

The ONLY accused device
in THE CASE AT BAR

ciently clear and cogent to make it unnecessary for us to argue this point beyond reliance upon said decision (81 Fed 2d 786) and the authorities cited therein.

The Chart facing this page will further serve to show the identity of the issues involved in the case at bar and in the Jiffy case with respect to the scope of the Butler patent and the conflict of opinion of the two Circuits (7th & 8th) with respect to the scope of the Butler patent.

We submit that the decision of the Court of Appeals for the Eighth Circuit as to the scope of the Butler patent is correct, and that the decision of the Court of Appeals for the Seventh Circuit in the case at bar with respect to the scope of the same patent is erroneous and should be reviewed and reversed by this Court.

ARGUMENT OF POINT II.

A patentee may not re-monopolize an old-style grease-cup or so-called "nipple" or "fitting" **on the basis of an asserted improvement in a hose-coupler usable therewith.**

Precisely this point was decided **against this plaintiff-respondent** in Rogers v. Alemite, 298 U. S. 415, 425, upon a state of facts as identical with the state of facts in the case at bar, as the state of facts could ever be alike in any two patent infringement suits based upon two different patents.

If anything, the facts in the case at bar are even less favorable to plaintiff-respondent's position than were the corresponding facts in its Rogers v. Alemite case.

Thus, in its earlier Rogers v. Alemite suit, the Gullborg coupler was not only found to be improved and patentable but was in reality manufactured and widely distributed by plaintiff-respondent.

In the case at bar, however, plaintiff-respondent has clearly **not** manufactured or sold **any** coupler in accordance

with the Butler patent, as held by the Circuit Court of Appeals in respondent's earlier Jiffy suit (81 Fed 2d 786; certiorari denied 299 U. S. 554).

The facts in the case at bar are also less favorable to respondent than were the corresponding facts in the Rogers v. Alemite case, for the further reason that while in the Alemite case Gullborg's improved coupler was claimed to have *done* something new to the old-style (bayonet or "pin-fitting" type) grease-cup there sought to be re-monopolized,

> that is, ostensibly "sucking" the slight excess of grease off the end of the grease-cup upon the disunion of the coupler therefrom and so "cleansing" the grease-cup;—

there is not even the remotest suggestion in the case at bar that Butler's assertedly improved hose-coupler *does* anything new to the old-style "headed" grease-cup or "nipple" sought to be re-monopolized in the case at bar.

Thus, while Butler's assertedly improved hose-coupler may be asserted to grip or grab or seal better than the other multi-jawed "chuck" type hose-couplers of the prior art, there is not the remotest suggestion that anything new happens to the old style "headed" grease-cup or "nipple" when assertedly better grabbed or gripped or sealed by the Butler coupler.

Thus, the question in case at bar, just as in Rogers vs. Alemite (298 U. S. 415), is whether a patentee may re-monopolize an old-style grease-cup, merely because he has allegedly invented an assertedly improved hose coupler usable therewith (in place of the hose-coupler of the prior art theretofore used with such old-style grease-cup).

Stating the matter in a different way: can an inventor of an improved and presumably patentable hose-coupler

also have a monopoly on all the old-style headed grease-cups, "fittings" or "nipples" with which his improved hose-coupler is adapted to be used and must necessarily be used? (even assuming that such assertedly improved hose-coupler grips or grabs the old-style grease-cup better than it had theretofore been gripped or grabbed by the prior-art hose-couplers, and even assuming that the patentee's improved hose-coupler makes a better fluid-seal than did the prior-art hose-couplers).

This is indeed a fundamental question of patent law because if the patentee of an improved hose-coupler can also have a monopoly of the old-style grease-cup, "fitting" or "nipple" with which his hose-coupler would normally be used, then the same old grease-cup, "fitting" or "nipple" can be re-monopolized for as many successive seventeen-year periods as there can be improvements in a hose-coupler.

Thus, for instance, the very "bayonet" type grease-cup or so-called "pin-fitting" which this Court said could **not** be re-monopolized under claims 1, 2, 3, 4 and 8 of Gullborg patent No. 1,307,734 (298 U. S. 415) could then, under respondent's theory of the case at bar **be** re-monopolized under its much more recent Butler patent here in suit.

Thus, in the Jiffy case (81 Fed 2d 786) the old and heretofore much litigated (298 U. S. 415) "bayonet" type grease-cup or so-called "pin-fitting" **was indeed** asserted by respondent to **be** the grease-cup or "nipple" element of its Butler claim 1.

Thus, as Butler claim 1 does not call for a "headed" nipple but merely a "nipple for receiving lubricant", and as multi-jawed "chuck" type hose-couplers can be and are also made with smooth-surfaced gripping jaws (as for in-

stance, Jiffy's accused coupler) for gripping the smooth side-wall of the old and much litigated "bayonet" type grease-cup or so-called "pin-fitting", it would only be necessary under respondent's theory of the case at bar, that respondent should manufacture and widely distribute in the field a real Butler coupler of the diameter of the Jiffy coupler for use with the old and much litigated "bayonet" type grease-cup or so-called "pin-fitting". Thereafter, the competitive manufacture and sale by others of the old "bayonet" type grease-cups or so-called "pin-fittings"

either of the form of the now-expired Gullborg patents Nos. 1,307,733 and 1,307,734 (298 U. S. 415),

or of the still older form known prior thereto (and which this Court said respondent could not re-monopolize under its Gullborg patent 1,307,734),

could be charged to constitute *contributory* infringement of the Butler patent, under respondent's theory of the case at bar;—because such old "bayonet" type grease-cups or so-called "pin fittings" would then become the "nipple" of Butler claim 1, just as much as petitioner's herein accused old-style headed grease-cup is allegedly the "nipple" of Butler claim 2 in the case at bar.

The trial court as well as the Court of Appeals for the Seventh Circuit in the case at bar confused two different kinds of "combinations", that is,

1) the combination of mechanical elements which compose or constitute, or go to make up the one device assertedly improved by the patentee, that is, the hose-coupler,

and

2) the so-called "*combination*" between (or what in reality is, merely the conjoint use of) the pat-

> entee's assertedly improved hose-coupler and the old-style grease-cup and old-style pump;—with which his assertedly improved hose-coupler must necessarily be used in order to have utility.

Thus, while Butler may have invented* a novel combination of **coupler-composing** elements (constituting an improved hose-coupler), he did **not** invent any *"combination"* of grease-cup, pump and coupler, because grease-cups, pumps and couplers had been used or *"combined"* with each other long before Butler in the same way that Butler *"combined"* them.

The Court of Appeals for the Seventh Circuit in the case at bar has erroneously failed to distinguish between the possible patentability of a new combination of **coupler-composing** elements on one hand, and the manifestly unpatentable old *combination* of grease-cup, pump and coupler, on the other hand;—the latter old *combination* **not** being rendered *"new"* merely by substituting an improved coupler for the old coupler.

The decision of both the trial court as well as the Court of Appeals for the Seventh Circuit in the case at bar is manifestly erroneous on the question of law here involved, as can be shown by the simplest and plainest application of the language of this Court's opinion in the Rogers v. Alemite case, to the precisely parallel facts of the case at bar.

The controlling effect of this Court's decision in Bassick v. Hollingshead and Rogers v. Alemite (298 U. S. 415, 424, 425) upon the questions at bar, is clear from the following quotation from page 425, wherein we have inserted parenthetically certain explanatory terms:

---

*just as did Gullborg in the Bassick-Alemite cases (298 U. S. 415).

> "It is plain that Gullborg **(and likewise Butler)** . . . . invented an improved form of (*grease-delivery*) coupler to be attached to the end of the hose leading from the (*old*) pump to the (*old*) fitting (*the grease-cup or 'nipple'*). Instead of patenting this, . . ., he claimed a combination of pump, hose-coupler, and pin-fitting, **('headed' instead of 'pin' in the case of Butler)**, and embodied in the combination his improved form of (*grease-delivery*) coupler."

This Court then further said:

> "The question then is whether, by this method, the patentee, by improving one element (*or one device, as for instance, the hose-coupler*) of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element (*his improved coupler device*) substituted for the old element (*the old prior-art coupler*). That this cannot be done is shown by numerous cases in this and in other federal courts".

This Court then further went on to say:

> "We are of the opinion that the owner of the patents . . . cannot extend the monopoly of the combination patent in suit to prevent the use of a (*old*) pin-fitting **(headed fitting or 'nipple' in the case of Butler)** which does not infringe the fitting patent, 1,307,733 (*that is, a pin-fitting or grease-cup or 'nipple' of the prior art*) with a gun (*or pump*) having a (*grease-delivery*) coupler such as that claimed in the patent in suit."

Thus, to paraphrase the above-quoted language of this Court in the Rogers v. Alemite case, to apply it to the case at bar, it is merely necessary to substitute the name "Butler" instead of the name "Gullborg", and to change the word "pin" to the word "headed".

The above quoted decision of this Court in the Rogers v. Alemite case was deemed absolutely controlling by the District Court for the Western District of Pennsylvania in respondent's two suits against the same Rogers and against the Universal Lubricating Systems Inc. and others, in which suits the decision is reported at 15 F. Supp. 410. Indeed, that District Court considered this Court's above quoted decision in the Rogers v. Alemite case so controlling that it did not consider it necessary to pass upon nor to decide any of the other issues of fact and law raised during a trial lasting almost five weeks.

Thus after quoting from this Court's opinion in the Rogers v. Alemite case (298 U. S. 415), the District Court, in its published opinion in the Stewart-Warner v. Rogers and Universal case (15 F. Supp. 410) said:—

> "On this ruling, we conclude that all of the claims of the patents in suit are invalid, because the patentees are merely claiming an old combination whose construction and operation are not changed merely by substituting an improved element of this combination for an old element. The plaintiff's bill will be dismissed."

The same District Court further said in its Findings of Fact (not published):—

> "11. **The alleged novelty and improvement, if any,** of each of the patents in suit **is in the mechanism or construction or structural characteristics of the particular coupler or nozzle disclosed in each patent.**
>
> "12. **The construction and operation of the old combination** or system of: (a) nipple; (b) pump; (c) coupler or nozzle is **not changed by the allegedly novel or coupler improvement** of the respective patents in suit. (Emphasis supplied.)

And in its Conclusions of Law said:—

> "The above findings and conclusions make it unnecessary for us to pass on any of the other issues of fact and law raised during the trial, as these findings and conclusions conclusively lead to the dismissal of the suit without passing upon any of the other issues raised."

The absolute parallelism between the facts of the case at bar and the facts involved in Rogers v. Alemite (298 U. S. 415) can best be shown from the following comparative columns:—

In the Case at Bar:	**In the Rogers vs Alemite Case:**
Butler made an alleged improvement in the internal construction or mechanism of an otherwise *old* "chuck" type (multi-jawed) hose-coupler for making perhaps a better "chuck-coupled" connection between	Gullborg made an improvement in the internal construction or mechanism of an otherwise *old* "bayonet" type hose-coupler for making perhaps a better "bayonet-coupled" connection between
1) the *old* "headed" type grease-cup or "nipple" or "fitting" of the prior art	1) the *old* "bayonet" type grease-cup or "nipple" or "fitting" of the prior art
and	and
2) the *old* grease pump, compressor, or "grease-gun" of the prior art.	2) the *old* grease pump, compressor, or "grease-gun" of the prior art.
Butler (in his claims) claims his specific and al-	Gullborg claimed his specific and allegedly im-

In the Case at Bar:	In the Rogers vs Alemite Case:
legedly improved "chuck" type hose-coupler in so-called *"combination"* with	proved "bayonet" type hose-coupler (in claims 1, 2, 3, 4, & 8 in issue) in so-called *"combination"* with
the *old* "headed" type grease-cup or "nipple" or "fitting" of the prior art	the *old* "bayonet" type grease-cup or "nipple" or "fitting" of the prior art
and	and
the *old* pump or compressor of the prior art.	the *old* pump or compressor of the prior art.
Respondent, under its later Butler patent here in suit, charges *contributory* infringement, by reason of defendant-petitioner's sale of old and unpatented "headed"-type grease-cups, "fittings" or "nipples" of the prior art, merely because such old grease-cups were adapted and intended for use, inter alia, with the *allegedly** Butler-improved "chuck" type hose-couplers manufactured and sold by plaintiff-respondent.	Respondent, under its earlier Gullborg patent, charged *contributory* infringement, by reason of defendant-petitioner's manufacture and sale of old and unpatented bayonet-type grease-cups, "fittings" or "nipples" of the prior art, merely because such old grease-cups were adapted and intended for use, inter alia, with the Gullborg-improved bayonet-type hose couplers manufactured and sold by plaintiff-respondent.

* See explanation on page immediately following these parallel columns.

In the Case at Bar:

In the case at bar plaintiff-respondent charges **no** infringement of Butler claim 2 by defendant-petitioner's manufacture or sale of **any** couplers (or pumps), even though the asserted novelty of the Butler claim is predicated solely upon the particular internal construction of the coupler;—the **only** one of the several separate and distinct devices included in the Butler claim which is specifically defined therein in terms to distinguish it from the corresponding prior-art device.

The sole charge of infringement in the case at bar is levelled at defendant-petitioner's old and unpatented grease-cup or so-called "fitting" or "nipple", which is one of the several separate and distinct devices included in Butler claim 2, without, however, any specific definition thereof in this claim;—the grease-cup or "nipple"

In the Rogers vs Alemite Case:

In the Rogers vs Alemite case respondent charged **no** infringement of Gullborg claims 1, 2, 3, 4, & 8, by petitioner's manufacture or sale of **any** couplers (or pumps), even though the asserted novelty of these claims was predicated solely upon the particular internal construction of the coupler;—the **only** one of the several separate and distinct devices included in these Gullborg claims which was specifically defined therein in terms to distinguish it from the corresponding prior-art device.

One of the two charges of infringement in Rogers vs Alemite, was levelled at petitioner's old and unpatented grease-cup or so-called "nipple" or "fitting", which was one of the several separate and distinct devices included in Gullborg claims 1, 2, 3, 4, & 8, without, however, any specific definition thereof in these claims;—the grease-cup or

In the Case at Bar:

being defined in the claim merely in broad and all-inclusive terms not distinguishing from the grease-cups or "nipples" of the prior art.

Plaintiff-respondent's theory of infringement (levelled at defendant-petitioner's old and unpatented grease-cup), in the case at bar, is that when one of pliantiff-respondent's own *allegedly** Butler-improved couplers (and an old pump) is applied momentarily to defendant-petitioner's old grease-cups at some automobile service station where the owner of the automobile equipped with these defendant-petitioner's accused grease-cups would take it for occasional "greasing", then, during each momentary application of one of plaintiff - respondent's *allegedly** Butler - improved couplers (and an old pump), the entire **assemblage** of the several distinct devices de-

In the Rogers vs Alemite Case:

"nipple" being defined in the claims merely in broad and all-inclusive terms not distinguishing from the grease-cups or "nipples" of the prior art.

Plaintiff-respondent's theory of infringement (levelled at defendant-petitioner's old and unpatented grease-cup), in the Rogers vs Alemite case was that when one of respondent's own Gullborg - improved couplers (and an old pump) were applied momentarily to defendant - petitioner's old grease-cups at some automobile service station where the owner of the automobile equipped with these defendant-petitioner's accused grease-cups would take it for occasional "greasing", then, during each momentary application of one of plaintiff - respondent's Gullborg-improved couplers (and an old pump), the entire **assemblage** of the several distinct devices defined in

* See explanation on page immediately following these parallel columns.

In the Case at Bar:	In the Rogers vs Alemite Case:
fined in Butler claim 2 comes into being, and that the old grease-cup in such momentary **assemblage** is a device not made or sold by plaintiff-respondent, but indeed, made and sold by defendant-petitioner. This, according to plaintiff-respondent's theory of the case, constitutes **contributory** infringement on the part of defendant-petitioner;—the direct infringement taking place the few moments plaintiff-respondent's *allegedly** Butler-improved coupler is connected onto the grease-cup during the automobile's occasional visit at a grease-service station.	Gullborg claims 1, 2, 3, 4, & 8 would come into being, and that the old grease-cup in such **assemblage** would be a device not made or sold by plaintiff-respondent, but indeed, made and sold by defendant-petitioner. This, according to plaintiff-respondent's theory of the case, constituted **contributory** infringement on the part of defendant-petitioner;—the direct infringement taking place the few moments plaintiff-respondent's Gullborg-improved coupler is connected onto the grease-cup during the automobile's occasional visit at a grease-service station.

The only difference between the case at bar and the Rogers v. Alemite case is that while the Gullborg coupler improvement was in reality embodied by plaintiff in its commercial coupler device which it at once sold in substantial quantities, the couplers made by plaintiff-respondent allegedly embodying the Butler coupler improvement, are in fact **not** even made in accordance with the Butler patent and

* See explanation on page immediately following these parallel columns.

do **not** embody the Butler coupler improvement. This difference does **not** help plaintiff-respondent's position in the case at bar, but on the contrary, further detracts from it.

Plaintiff strenuously but unsuccessfully urged before the Court of Appeals for the 8th Circuit, in Stewart-Warner v. Jiffy (81 Fed 2d 786), that its commercial couplers, marketed under the trade designation of "Alemite Hydraulic" couplers, were in accordance with the Butler patent and within the scope of the claim thereof. The Court of Appeals for the 8th Circuit, however, in Stewart-Warner v. Jiffy (certiorari denied, 299 U. S. 554), held that plaintiff-respondent's own *allegedly* Butler-improved couplers were **not** Butler-improved at all, as they were **not** in accordance with the Butler patent here in suit and were **not** within the scope of the claim thereof. The decision of the Court of Appeals for the 7th Circuit in the case at bar is therefore in direct conflict with the decision of the Court of Appeals for the 8th Circuit in the case of Stewart-Warner v. Jiffy, as to the scope of the Butler patent here in suit.

The Court of Appeals for the Seventh Circuit in its decision in the case at bar (91 Fed 2d 757) recognized the far-reaching importance of its decision in the case at bar and the applicability of this Court's earlier decision in the Rogers v. Alemite case to the case at bar with respect to the first of the three grounds of appeal there presented to that Court by defendant-petitioner. Thus, the Court of Appeals for the Seventh Circuit in its opinion in the case at bar said (at p. 760):

> "Appellant challenges the decree on three separate, distinct grounds, stating each with commendable frankness, brevity, and clarity:
>
> "(1) Butler's hose coupler can not be validly claimed in combination with a non-patented lubricant

receiving nipple or an old compressor, particularly where his conceded purpose is not merely to monopolize the hose coupler, but to include in the monopoly the admittedly old device which is used with it. To support this position appellant relies upon *Bassick Manufacturing Co. v. Hollingshead Co.* and *Rogers v. Alemite Corp.*, 298 U. S. 415.

"(2) The coupler of the Butler patent shown in Figure 2 is not the so-called "Alemite Hydraulic" coupler. Supporting this position, appellant relies upon the fact brought out by the evidence and the holding in *Stewart-Warner v. Jiffy Lubricating Co.*, 81 Fed 2d 786.

"(3) The Butler multi-jaw chuck type hose coupler is not a patentable improvement over the multi-type hose coupler of the prior art. As bearing upon this issue, it contends that the evidence does not support the finding of validity because the Butler hose coupler as described by Butler both in Figure 2 and in his claim never went into commercial use. It likewise argues that extensive use where the trade was so dominated by Stewart-Warner is not persuasive of validity.

"**The importance of the suit and the effect of the Bassick opinion upon the whole field of patent law** make it impossible for us to dispose of the case in an opinion of desirable and satisfactory brevity (emphasis here supplied).

"While going no further than is necessary to defeat the patent in the present case, the conclusion from appellant's brief is unavoidable, that *Bassick v. Hollingshead, supra,* revolutionized the law of patents and repudiated the position of courts, including many decisions in this circuit, long accepted as the law in patent cases. This revolutionary concept was accepted and applied by the District Court (in Pennsylvania) in *Stewart-Warner v. Universal Co.*, 15 F. Supp. 410.

"The Bassick opinion, while dealing with another patent, is more persuasive in this case, because the patent in issue here deals with some of the same old elements of a combination as were described in the Gullborg patent, the validity and infringement of which were the subject matter of the *Bassick v. Hollingshead* opinion.

"The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here with (1) a type of pin fitting, (2) a grease gun, (3) a connecting hose, and (4) a type of coupler.

"While it is, of course, conceded that every opinion must be read in the light of the facts to which it applies, yet there are cases where the differences in the facts are so inconsequential, so immaterial, that the opinion must be accepted as authoritative and controlling.

"The uppermost question in this case is the controlling effect of the *Bassick v. Hollingshead* opinion, *supra*. We are not disposed to limit it in order to bring about an avoidance of any new principle it may announce. Nor are we inclined to give it an effect which was not intended, if it does not follow from a fair construction of its language.

"**The novel proposition** * which appellant seeks to apply to the present case is to be found in the language on pages 424, 425. There it was said:

> " 'It is plain that Gullborg invented improvements of two of the mechanical elements of an old combination consisting of grease pump, hose, hose-coupler and a grease cup or pin fitting. This he patented as such (No. 1,307,733). Secondly, he invented an improved form of coupler to be attached to the end of the hose leading from the pump to the fitting. Instead of patenting this, as he did the

* Emphasis ours.

> pin fitting, he claimed a combination of pump, hose-coupler, and pin fitting, and embodied in the combination his improved form of coupler. (No. 1,307,734, the patent in suit; claims 1-6, 8 and 10.) He further claimed the combination between his patented pin fitting and any form of grease gun whether that claimed in his patent or unpatented and old in the art. (Claims 14 and 15.) *The question then is whether, by this method, the patentee, by improving one element of an old combination whose construction and operation is otherwise unchanged, may, in effect, repatent the old combination by reclaiming it with the improved element substituted for the old element.** That this cannot be done is shown by numerous cases in this and other federal courts.' "

What the Court of Appeals for the Seventh Circuit in the case at bar has characterized as "the novel proposition" is seemingly that part of this Court's opinion in the Rogers v. Alemite case which the Court of Appeals for the Seventh Circuit emphasized by italics in quoting from this Court's opinion as last above shown;—that emphasis having been supplied by the Court of Appeals in its own quotation from this Court's opinion.

At the outset, plaintiff-respondent admitted in its brief addressed to the Court of Appeals for the Seventh Circuit in the case at bar that if the first issue presented to that Court by defendant-petitioner was correctly stated, that then "there can be only one answer,—the answer which defendant wants".

Thus, the first issue presented by us to the Court of Appeals for the Seventh Circuit in the case at bar was:

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* Emphasis by the Circuit Court of Appeals.

"Can an improvement in a hose coupler be the basis for a valid monopoly on an old headed nipple or an old compressor which is to be used with it?"

The Circuit Court of Appeals conceded the correctness of petitioner's statement of said first issue, which, even according to respondent, could be answered only favorably to petitioner. Notwithstanding this, however, the Circuit Court of Appeals answered said issue unfavorably to petitioner.

Petitioner respectfully submits that this Court's opinion in the Bassick v. Hollingshead and Rogers v. Alemite, 298 U. S. 415, is controlling on this point of law, particularly as the facts in that case and in the case at bar are precisely parallel, as even the Court of Appeals for the Seventh Circuit recognized in its opinion in the case at bar:

> "**The Bassick opinion,** while dealing with another patent, **is more persuasive in this case, because the patent in issue here deals with** some of **the same old elements of a combination** as were described in the Gullborg patent, the validity and infringement of which were the subject matter of the *Bassick v. Hollingshead* opinion.
>
> "The Gullborg patent had been the subject of much litigation, as pointed out in the opinion, and it dealt, as here with (1) a type of pin fitting, (2) a grease gup, (3) a connecting hose, and (4) a type of coupler.
>
> "While it is, of course, conceded that every opinion must be read in the light of the facts to which it applies, yet there are cases where the differences in the facts are so inconsequential, so immaterial, that the opinion must be accepted as authoritative and controlling."

Thus,

while plaintiff-respondent has conceded on page 3 of its main brief addressed to the Court of Appeals for the Seventh Circuit in the case at bar that on the first issue there presented (here certiorari ground No. 2 and argument point No. 2) "there can be only one answer,—the answer which defendant (petitioner) wants", and

while the Court of Appeals for the Seventh Circuit could find no fault with our statement of issue No. 1 there presented by us (present certiorari ground No. 2 and present argument point No. 2) but instead commended us for the frankness, brevity and clarity of our statement of the issue,

the Court of Appeals for the Seventh Circuit nevertheless decided against petitioner and contrary to and in conflict with this Court's recent ruling and decision on a precisely parallel factual situation and the same question of law (298 U. S. 415).

We respectfully submit that the decision of the Court of Appeals for the Seventh Circuit in the case at bar on this second point is manifestly erroneous and in conflict with the decision of this Court in the Rogers v. Alemite case and other decision of this and other Federal Courts and should be reviewed and reversed by this Court.

ARGUMENT OF POINT III.

Butler claim in suit invalid as drawn to (or because claiming) an old and exhausted combination of grease-cup, pump and coupler;—whereas patentee's improvement, if any, is merely in the assertedly improved coupler.

The Court of Appeals for the Seventh Circuit in the case at bar has erroneously held, in effect, that one who invents an improvement in **one** device normally useful in conjunction (or in an old combination) with **other** devices of the prior-art, need not content himself with merely claiming his assertedly improved device, per se, but may validly claim his improved device *in the old combination* where it is normally to be used.

The aforesaid decision of the Court of Appeals for the Seventh Circuit in the case at bar is clearly in conflict with the applicable decisions of this Court and other appellate courts, as shown by the following decisions:—

Heald v. Rice, 104 U. S. 737, 755;
Underwood v. Gerber, 149 U. S. 224, 227;
General Electric Co. v. Ohio Brass Co., 277 Fed 917;
Langen v. Warren Axe & Tool Co., 184 Fed 720;
In re Ratican, 36 App. D. C. 95;
In re Germantown Trust Co., 57 Fed 2d 365 (U. S. Ct. of Customs & Patent Appeals);
Kodell Electric v. Warren Telechron, 62 Fed 2d 692 (C. C. A. 6);
Alemite Corp. v. Lubrair Corp., 62 Fed 2d 899 (C. C. A. 1);
Rogers v. Alemite
Bassick v. Hollingshead } 298 U. S. 415.

The first four of the above cited cases were cited by this Court in its recent decision in Rogers v. Alemite and Bassick v. Hollingshead (298 U. S. 415).

Section 4888 of the Revised Statutes of the United States (U. S. C. Title 35, Sec. 33) not only requires the applicant for a patent to make a full and clear disclosure of his alleged invention, but also further requires that "he shall particularly point out and distinctly claim the part, improvement or combination which he claims as his invention or discovery."

It is because of this statutory requirement that each patent contains (or that the specification of each patent concludes with) one or more claims.

However prolix the patentee may have been in describing his invention in the specification of his patent, he must, at least in his claims, clearly delineate between that which he really invented and that which he did not invent (or that which was in the public domain).

Thus, however loosely a patentee may describe* his invention in relation to the prior-art to which it relates, nevertheless in the claim or claims of his patent, he must *not* commingle that which he invented, with that which is in the public domain. Otherwise, the statutory requirement for claims is completely vitiated. Unless this statutory requirement is complied with, the public has no possible way of knowing where the patentee's contribution begins and where it ends.

In the case at bar, just as in the case of Gullborg claims 1, 2, 3, 4, and 8, adjudicated by this Court (at 298 U. S. 415), the patentee's contribution, if any, was in an assertedly improved hose-coupler. That is where the pat-

* In the descriptive portion of his specification.

entee's contribution ends however. There was no further invention involved in the mere idea of using the assertedly improved hose-coupler in a way that hose-couplers had always been used, that is, in conjunction with the other two old devices (grease-cup and pump) requiring to be coupled or needing a coupler.

Respondent's misconceived theory of patent-claiming in the case at bar, is merely that if the coupler is new, then, as a matter of form, the coupler plus old grease-cup plus old pump is also "new".

Precisely that was the situation in the case of Gullborg claims 1, 2, 3, 4 and 8 involved in Rogers v. Alemite (298 U. S. 415).

Gullborg even went so far in some of the claims as to include as an element of the claimed "combination", the machinery such as the automobile requiring to be lubricated. Thus, for instance, Gullborg claim 8 adjudicated by this Court not only included in the so-called "combination" (with the assertedly improved hose-coupler) the admittedly old pump, hose and grease-cup, but also included the "apparatus having a part to be lubricated";—this last phrase generically defining (in the *claim*) the automobile or other machine to which the grease-cup may be attached.

Thus, according to respondent's misconceived theory of patent-claiming, anyone inventing a better or improved coupler may claim in so-called "combination" therewith, the old pump and old grease-cup;—merely because the old pump and old grease-cup are to constitute the environment in which the improved coupler is to be used. It is respondent's theory therefore that if the coupler is new, then naturally the *combination* with it of an old pump and old grease-cup must, as a matter of course, also be new.

The fallacy of this theory of patent-claiming has been exposed many times in the decisions hereinabove cited on page 37. The fallacy of this theory of patent claiming will further be apparent when it is recognized that by far the largest bulk of all mechanical devices now in common use (both old and new) are not useful alone, but only when used in conjunction (or in so-called "*combination*") with other devices.

Thus, an improved bottle-cap-opener is not useful by itself but only when used in conjunction (or in so-called "*combination*") with an old bottle and an old bottle-cap. It will be conceded that there is co-action and cooperation between the bottle-cap-opener, on one hand, and the bottle-cap and bottle, on the other hand;—indeed they all work together when the bottle-cap-opener is in actual operation. It will also be conceded that an improved bottle-cap-opener may grip or grab the bottle-cap better than some other unimproved bottle-cap-opener.

Likewise, an improved lamp-socket undoubtedly operates and co-acts with the old electric bulb which it is adapted to receive, and may indeed hold the electric bulb better and make better electrical contact with it than some other unimproved electric socket.

Likewise, an improved quick-detachable and quick-attachable hose-coupler for connecting the old fire-engine to the old fire-hydrant at the street curb or with the old standpipe (on the side of the skyscraper) co-acts with and cooperates with the fire-engine and the fire-hydrant, and may indeed make a much better coupling between the old fire-engine and the old fire-hydrant than that made by some other unimproved coupler.

So, whenever any single device is improved, can it be said that the patentee also invented the "*combination*"

therewith of the old devices with which it is to be used? Obviously not.

As pointed out by this Court in Heald v. Rice (104 U. S. 737, 755), the inventor of an assertedly improved return-flue boiler for use with an old straw-feeding device, did not invent a new *combination* of boiler plus straw-feeding device. He merely invented a new return-flue boiler (if anything). The claim on the *combination* of boiler and straw-feeding device was therefore held invalid.

Likewise, an improved coating composition may constitute a patentable improvement. As pointed out however by this Court in Underwood v. Gerber (149 U. S. 224, 227), there is no further invention involved in the idea of coating the improved coating composition onto a sheet of paper, as coating compositions had always been combined with paper.

Or, as pointed out by the Court of Appeals for the Third Circuit in General Electric v. Ohio Brass (277 Fed 917), while there may be patentable invention in an improved electrical insulator, there is no invention in the idea of combining the improved insulator with the old poles and cross arms and electrical wires with which other old and unimproved insulators had customarily been used.

So in the case at bar, there was no patentable or inventive concept involved in putting an assertedly improved hose-coupler to use in conjunction with the old grease-cup and old pump;—irrespective of whether the coupler itself may be an improved and patentable coupler.

For this reason, the Butler claim is invalid as drawn to an old and exhausted combination of grease-cup, pump and coupler, whereas Butler's invention, if any, was merely in the internal construction or mechanism of the coupler (that is, the combination of coupler-composing elements). The Butler claim in suit therefore violates Sec-

tion 4888 of the Revised Statutes in that the patentee has commingled in his claim that which at best was his contribution and that which was clearly and most obviously within the public domain (the old grease-cup and old pump). The decision of the Circuit Court of Appeals in the case at bar should therefore be reviewed and reversed by this Court.

ARGUMENT OF POINT IV.

Point IV-a:

Section 3 of the Clayton Act prohibits the monopoly herein asserted by respondent and erroneously sustained by the Court of Appeals.

Respondent may NOT restrict the proper and only possible use of the assertedly Butler-invented hose-couplers of its own manufacture, to the use of such couplers solely with grease-cups of its own manufacture and to the exclusion of grease-cups manufactured and sold by petitioner;—notwithstanding respondent's ownership of a patent assertedly covering its hose-coupler in so-called "combination", broadly, with any old grease-cup,

or otherwise stated:

Respondent may NOT impose as a condition of sale of its assertedly Butler-invented hose couplers, that the purchasers shall not use the same in conjunction with old-style grease-cups manufactured and sold by petitioner;—notwithstanding respondent's ownership of the patent in suit which claims an improved hose coupler in so-called combination with an old-style grease-cup. Such condition of sale is violative of Section 3 of the Clayton Act.

Point IV-b:

Under the principle of estoppel, purchasers of respondent's assertedly Butler-invented "Alemite Hydraulic" cou-

plers are impliedly licensed to use the same with any old and unpatented grease-cups including those of petitioner.

While the courts have from time to time approached the problem of improper *"combination"* claims through several different avenues of approach, the result has always been the same, to wit, the denial of the patent owner's asserted monopoly of old and unpatentable devices.

In foregoing **Argument Point II**, we have pointed out this Court's treatment of precisely the same problem in the case of Rogers v. Alemite (298 U. S. 415).

In Rogers v. Alemite (298 U. S. 415) this Court solved the problem of improper *"combination"* claims upon the broad proposition that a patentee could **not** re-patent the old combination of grease-cup, pump and coupler (regardless of the presence of some asserted improvement in the coupler), and could **not** so remonopolize the old grease-cup.

In support of its decision, this Court cited a number of earlier decisions of its own and also other Federal Courts. The decisions cited by this Court in support of its decision in Rogers v. Alemite may be classified into three groups according to the manner in which the Court approached and solved the problem of improper *"combination"* claims involved in the particular case.

Thus, some of the authorities cited by this Court in its opinion in Rogers v. Alemite hold that such improper *"combination"* claims are invalid as drawn to an old and exhausted combination, whereas the asserted improvement, if any, is merely in the construction of one of the elements:

Heald v. Rice, 104, U. S. 737, 755;
Underwood v. Gerber, 149 U. S. 224, 227;
Langan v. Warren Axe & Tool Co., 184 Fed 720;
Troy Wagon v. Ohio Trailer, 274 Fed 612;

General Electric v. Ohio Brass, 277 Fed 917 (C. C. A. 3);

Wall Pump Co. v. Gardner, 28 Fed 2d 334, 338 (C. C. A. 7).

The general point of law upon which the last above-cited decisions rest, constitutes our **Argument Point III**; wherein we have relied upon these decisions and others covering the same point of law, to the effect that when one invents the asserted improvement in one device he may claim the combination of elements constituting that one device, but may not claim the so-called "combination" of that one (assertedly improved) device with other old devices with which it is normally used.

The following authorities cited by this Court in its Opinion in Rogers v. Alemite hold that such improper "combination" claims which claim an assertedly improved device in so-called "combination" with one or more old devices (with which the improved device must be used) cannot be asserted either through a patent infringement suit or through patent license contracts (with licensees under the patent) to prevent or restrict the use of the old and unpatented devices manufactured by others:

Morgan Envelope Co., v. Albany Paper Co., 152 U. S. 425, 431, 432;

Carbice v. American Patents Corp., 283 U. S. 27, 31, 32;

Wagner v. Webster, 144 Fed 405, 409;

Harvey-Hubbell v. General Electric, 267 Fed 564;

Radio Corp. v. Lord, 28 Fed 2d 257.

On the other hand, the case of Edison Electric Light Co. v. Peninsular Light Co., 101 Fed. 831 (C. C. A. 6) cited by this Court in its opinion in Rogers v. Alemite, solves the

problem of improper "combination" claims by holding that the purchaser of the inventive device (from the patentee), has an implied license to use with it the old and uninventive devices purchased from others;—notwithstanding the fact that such old and uninventive devices are included generically in the patent claim.

The last two groups of authorities, and others on the same points of law are relied upon as authorities for **Argument Point IV**, parts **a** and **b** respectively.

Whether the controversy arises as a patent infringement suit, as in the cases of

Morgan Envelope v. Albany Paper, 152 U. S. 425, 431, 432;

Carbice v. American Patents Development Corp., 283 U. S. 27;

Wagner v. Webster, 144 Fed 405, 409;

Harvey-Hubbell v. General Electric, 267 Fed 564;

or whether it arises under a patent contract as in the cases of

United Shoe Mach. Corp. v. U. S., 258 U. S. 451;

Radio Corp. v. Lord, 28 Fed 2d 257 (C. C. A. 3); (Certiorari denied, 278 U. S. 648);

International Business Machines Corp. v. U. S., 298 U. S. 131;

the courts have uniformly held that competitive sale of the old and unpatented devices or articles of commerce which may be generically included in the claims of a patent (in conjunction with some *other* device presumably invented by the patentee) may **not** be prohibited or restricted or in any way curtailed.

The courts have so held regardless of whether the prohibition, restriction or curtailment was attempted to be worked through the assertion of the patent against such competitive old devices under the theory of patent infringement, as in the first group of cases last above cited, or whether such prohibition, restriction or curtailment was attempted to be worked through a license contract or other contract with licensees or users under the patent in question, as in the second group of cases last above cited.

Thus, there is no conflict whatever between the patent laws and the anti-trust laws. On the contrary, the patent laws were not intended to grant monopolies on old and unpatented devices or articles of commerce and the anti-trust laws expressly prohibit such monopolies.

In the case at bar, the Court of Appeals for the Seventh Circuit has erroneously sustained respondent's asserted monopoly of admittedly old and unpatentable "headed" grease-cups or so-called "nipples" or "fittings." Such monopoly was not contemplated by the patent laws and is expressly prohibited by the anti-trust of the United States. Therefore, for this further reason, the decision for the Circuit Court of Appeals for the Seventh Circuit in the case at bar should be reviewed and reversed by this Court.

The problem of improper "combination" claims was dealt with in the following cases under the principle of implied license by estoppel:

Edison Electric Light Co. v. Peninsular Light, Power & Heat Co., 101 Fed. 831 (C. C. A. 6);

Thomson-Houston Electric Co. v. Illinois Telephone Construction Co., 152 Fed 631 (C. C. A. 7).

Thus, in these cases, the Court, in an effort to save the patentee from the harsher consequences of the improper form of his patent claims, held that the defendant had an implied license to manufacture and sell and use the old and unpatentable devices of the prior-art, which were generically included in the patent claim. This was on the theory that when the patentee sold the inventive devices without restriction or limitation, he impliedly granted to the purchaser of such inventive device the license to use the same with the old and unpatentable devices of the prior art with which it had to be used in order to have utility.

Thus, in the case at bar, respondent sold its assertedly Butler-invented couplers and the old pumps without restriction or limitation and the purchasers of such assertedly Butler-invented couplers and old pumps (of respondent's manufacture) necessarily have the implied license to use such devices in the only way they were intended to be used and the only way in which they could be used; that is, in conjunction with the old and unpatentable "headed" grease-cups or so-called "nipples" or "fittings." The purchasers from respondent (of its assertedly Butler-invented couplers and old pumps) having such an implied license, it necessarily follows that any member of the public, including petitioner, has a right to supply such old and unpatentable "headed" grease-cups or so-called "nipples" or "fittings" for use with the assertedly Butler-invented couplers and old pumps purchased from respondent.

The decision of the Court of Appeals for the Seventh Circuit is therefore clearly erroneous and in conflict with this last cited line of authorities and should, for that reason also, be reviewed and reversed by this Court.

CONCLUSION.

In conclusion, it is respectfully submitted that the decision and judgment of the Court of Appeals for the Seventh Circuit should be reviewed (and reversed) by this Court, and to that end, a writ of certiorari should be granted by this Court; for the reason that said decision and judgment of the Circuit Court of Appeals for the Seventh Circuit

is in direct conflict with the decision of the Circuit Court of Appeals for the Eighth Circuit as to the scope of the same patent (Stewart-Warner v. Jiffy, 81 Fed 2d 786, certiorari denied 299 U. S. 554);

is in direct conflict with the decision of this Court as to another patent just like the patent here in suit and presenting precisely parallel facts and the same legal situation (Rogers v. Alemite, 298 U. S. 415);

is in direct conflict with the decision of the United States District Court for the Western District of Pennsylvania as to the validity of the same patent as involved in the case at bar, which District Court held the patent here in suit invalid on the controlling authority of this Court's decision in the Rogers v. Alemite case (Stewart-Warner v. Rogers & Universal, 15 F. Supp. 410);

is in direct conflict with the earlier decisions of this and other Federal Courts on the point of law that a claim drawn to an old and exhausted combination of several separate and distinct devices (customarily used with each other) is invalid where the patentee's improvement is merely in the construction of one of the several devices;

is in direct conflict with the earlier decisions of this and other Federal Courts on the point of law that the patent owner who has manufactured and sold an

assertedly improved and patentable device (a hose-coupler) may not prohibit or restrict the use thereof by reason of his ownership of a patent covering his improved device (coupler) in so-called "combination" with other old and unpatentable devices or articles of commerce with which it is normally to be used; or otherwise stated, the owner of a patent on a so-called "combination" of several separate and distinct devices or articles of commerce may not impose, as a condition of the sale of his assertedly improved device that the same shall not be used in conjunction with the other old devices of a competitor;

is in direct conflict with the earlier decisions of another Circuit Court of Appeals (and also the earlier decision of the same Circuit Court of Appeals) on the point of law that when the patentee sells his assertedly improved device without restriction, the purchaser acquires an implied license to use it with the other old and unpatentable devices with which it normally must be used in order to have utility, and under such implied license, any member of the public has a right to supply such old and unpatentable device or article of commerce.

Respectfully submitted,

LINCOLN ENGINEERING CO. OF ILLINOIS,
By LEONARD L. KALISH,
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LLOYD R. KOENIG,
Counsel for Petitioner.

APPENDIX I.

The following excerpts from plaintiff-respondent's briefs addressed to the Circuit Court of Appeals for the Eighth Circuit in the Jiffy case (81 Fed 2d 786) further show just what plaintiff-respondent did urge upon that Court as to the scope of the Butler patent. (emphasis supplied.)

Respondent urged in its Jiffy suit

(on page 3 of its main brief in CCA 8):—

"Lubricating equipment manufactured by the present plaintiff, Stewart-Warner Corporation, and first manufactured by its subsidiary, Alemite Corporation, and marketed under the name 'Alemite Hydraulic Type Lubricating Equipment,' immediately upon its commercial introduction displaced all other types of lubricating equipment on automobiles. This **Alemite hydraulic type of equipment embodies the invention of this Butler patent.** The language of claim 1 describes it with literal fidelity."

Respondent urged in its Jiffy suit

(on page 5 of its main brief in CCA 8):—

"The tremendous success of the plaintiff's Alemite hydraulic type of lubricating equipment is emphasized by the sales figures of Plaintiff's Exhibit No. 8, Rec. 345. These figures show that in the single year of 1934 the sales of plaintiff's hydraulic type of equipment amounted to two and one-quarter million dollars. **The** tremendous **commercial success of this** hydraulic type of **equipment is due solely to the advantages resulting from Butler's invention.**"

Respondent urged in its Jiffy suit

(on page 6 of its main brief in CCA 8):—

"The plaintiff's hydraulic type of equipment is protected by this Butler patent only if claim 1 be given its natural and literal meaning. The Alemite hydraulic equipment responds to the literal wording of claim 1 of Butler (Rec., 98-99), but **this hydraulic equipment does not have spring fingers** and is **not protected by this claim** with the additional limitation read into it by the District Court."

Respondent urged in its Jiffy suit

(on page 11 of its main brief in CCA 8):—

"This variation of Butler's Figure 2 has been adopted by **both** the plaintiff's Alemite hydraulic type of coupler and the defendant's Jiffy coupler."

Respondent urged in its Jiffy suit

(on page 12 of its main brief in CCA 8):—

"Claim 1 of the Butler patent reads on this Alemite hydraulic type of equipment just as clearly as it does on the disclosure of the Butler patent."

Respondent urged in its Jiffy suit

(on page 14 of its main brief in CCA 8):—

"The Commercial Success of the Alemite Hydraulic Type of Equipment Embodying the Invention of the Butler Patent Was Due to the Advantages Inherent in Butler's Invention.

"We have already pointed out that by 1930 all American-made passenger automobiles and trucks were factory-equipped with either the Alemite pin type of lubricating equipment made under Gullborg patent 1,307,734, or the Alemite push type of lubricating equipment made under Zerk patent 1,475,980, and that all passenger automobiles and trucks made in America continued to have one or the

other of these systems as factory equipment until the introduction of the Alemite hydraulic type of equipment in April, 1933. By January, 1934, all American-made automobiles, including both passenger vehicles and trucks, had changed over to the Alemite hydraulic type of lubricating equipment. (Rec., 66.)

"The rapid adoption of the **Alemite hydraulic** type of lubricating **equipment** by the automobile manufacturers was based on certain important **advantages** which this equipment has over the Gullborg and Zerk equipments previously used. These advantages are an **inherent part of Butler's invention.**"

Respondent urged in its Jiffy suit

(on page 2 of its reply brief in CCA 8):—

"(4) If **claim 1** of the Butler patent be given merely the plain and natural meaning of its words, then it **describes both (a) the "Alemite Hydraulic"** lubricating **equipment** sold by the plaintiff, **and (b) the 'Jiffy'** lubricating **equipment** sold by the defendant.

"(5) Within less than one year after its advent upon the market, the plaintiff's 'Alemite Hydraulic' lubricating system had completely displaced every other known means for lubricating the chassis bearings of automobiles,—to the extent that every automobile and truck manufactured in America was equipped at its factory with the 'Alemite Hydraulic' equipment. That condition has continued uninterruptedly to the date of the trial herein.

"(6) Even if claim 1 of the Butler patent be interpreted to mean the precise thing described and illustrated in Butler's specifications and drawings, still, **if** Butler is **entitled to** any **range of 'equivalents'** whatsoever, **then (a) the plaintiff's 'Alemite Hydraulic' equipment embodies the Butler invention, and (b) the defendant has infringed.**"

Respondent urged in its Jiffy suit

(on page 11 of its reply brief in CCA 8) :—

"Even here, however, the language of claim 1 does not support the twist which counsel attempt to give to it. What counsel for defendant-appellee attempt to make of this language is a statement that the piston must directly and immediately compress the locking jaws. They attempt to **distinguish** this fanciful **limitation from a construction like that of the Alemite Hydraulic system and the defendant's system, in which the actuation of the piston more indirectly compresses the locking jaws about the nipple for locking the parts together.**"

APPENDIX II.

The following excerpt from pages 49 to 54 of the transcript of respondent's oral argument before the Court of Appeals for the Seventh Circuit in the case at bar (reported by court stenographer Rankin) further confirms the fact that the Court of Appeals for the Seventh Circuit in the case at bar **did** reach a conclusion as to the scope of the Butler patent, in conflict with the conclusion reached by the Court of Appeals for the Eighth Circuit as to the scope of the same patent:

. . . . . .

"MR. WILLIAMS: . . . Now, there again I probably have not spent enough time on it to make absolutely clear all of the details of the construction, but I have gone into it with the idea of convincing your Honors, if I may, that the difference between the plaintiff's commercial construction and the disclosure of the patent involves the simplest kind of a mechanical reversal and equivalency.

JUDGE EVANS: What does the defendant sell?

MR. WILLIAMS: Beg pardon?

JUDGE EVANS: What does the defendant sell?

MR. WILLIAMS: What the defendant sells is this nipple part.

JUDGE EVANS: You don't make any claim that he sells the other part?

MR. WILLIAMS: That is right. Now, what defendant discloses is a piston—this is of course an enlarged model—piston acted upon by the grease with a wedging or camming surface at the forward end. In the shell of the coupler there are mounted some jaws and there is a piece of sponge rubber between those jaws. The result is that the grease pressure comes on as I shall simulate, those jaws are squeezed inwardly—I don't know whether your Honors can see that—squeezed inwardly, and it is the inward movement of

those jaws which grip about the neck of the nipple and hold the parts together during the injection of the grease.

Now, what the plaintiff has done in its commercial model is to reverse those jaws, and your Honors will see at the forward end of this enlarged coupler the ends of three jaws corresponding somewhat with the three jaws as they appear in this aluminum model. That has been turned; instead of that way it has been turned this way, and the part of the piston which formerly acted as the wedging cam has been incorporated into the outer shell here and the forward end of the piston in this instance has been left square like that. Now, your Honors will observe the three jaws and you will see again that they are squeezed inwardly in such a way as to grab about the neck of the fitting. There is that simple reversal, and that is one of the grounds which is urged by the defendant for saying that the parts which we sell do not embody the disclosure of the Butler patent and do not embody the claim of the Butler patent, although your Honors will find that the language of the claim is just as readable upon this reversed form as it is upon the other. Just because of that reversal the contention is made that we ourselves have not embodied the Butler patent in the thing that we sell and from that the argument is made that if the defendant sells a part of that combination it cannot contributorily infringe because we ourselves are not supplying other parts necessary to complete the infringement. Now, I want to skip to——

JUDGE EVANS: Starting with that last, that position is sound, is it not, if you were not selling a product that is the embodiment of a patent?

MR. WILLIAMS: **That would be conclusive. If what we sell does not embody,** so far as this goes, **the Butler invention, then nothing that the defendant could do** with the balance of the stuff **would be contributory infringement;**—but that, of course, is what we do sell.

JUDGE EVANS: **The point of that is that the Eighth Circuit has held that this does not embody.**

MR. WILLIAMS: Well, that is one of the things that counsel says and with which I disagree to this extent. In the Eighth Circuit Court of Appeals we had brought a suit against a concern which was engaged in, not making a gun as counsel says, but in making a coupler with a gun or compressor and the fitting part too and we brought suit against that Jiffy Company alleging infringement by its sale of the entire thing, and as showing the extent to which the Butler invention was gone into at that time, we offered evidence showing that the plaintiff had sold, as it has literally, millions and millions of guns and couplers and literally hundreds of millions of the fitting parts, and the Court of Appeals for the Eighth Circuit said, and that is a matter that I want to come to, said that as they viewed the Butler patent, it must be strictly limited to certain spring fingers so flimsy that there would be no effective gripping such as I have demonstrated by the coupler and the nipple, and that the plaintiff in its construction had effected the kind of a reversal that I have been showing to your Honors, and furthermore, that this construction was such that there was a powerful gripping, and they said that that was not the disclosure of the Butler patent and therefore they would not give the Butler patent the breadth or the scope requisite to hold the defendant, because it was not shown to have been a commercial success, that one claim.

JUDGE EVANS: This is what your opponent said, that they held that this was not entitled to that scope and also held that the coupler was originally copied from Jiffy, that they had made that very thing, and therefore you were necessarily——

MR. WILLIAMS: I don't remember exactly what they said about that.

JUDGE EVANS: **Your position is practically that we must reject that decision as to the scope of that patent.**

MR. WILLIAMS: It was not strictly an issue in this case, and **to the extent that the Eighth Circuit Court of Appeals**

said what they did upon the scope, I am urging your Honor to disagree. I say it was no ultimate issue in that case. It was a discussion of collateral evidence that might have swayed the Court on a question of invention, and trying to apply the facts, they reached the conclusion with which I do not agree upon that point. I am asking your Honors therefore, if not to disagree with them, at least to reach a different conclusion.''